Remarks

The present response is to the Office Action mailed the above-referenced case on January 6, 2006. Claims 1-26 are standing for examination.

In the present action the Examiner has imposed a restriction requirement, saying that newly-added claims 25 and 26 are drawn to a banking system, and are independent or distinct from the invention originally claimed, which is in class 705, subclass 1. The applicant has therefore cancelled claims 25 and 26 in this response, and reserves the right to submit these and similar claims in a continuing application in the future, claiming priority to the filing date of the present application.

In the present action the Examiner has rejected claims 1-12 under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner states that the claim language: "...a data store accessible to the server and storing information about individuals or families, pre-qualified for donations and associated each with a specified account with a financial institution..." is unclear, as it is unclear what the applicant means by "associated each".

The applicant responds that the language is perfectly clear and grammatically correct. Each individual or family is associated with a specific account with a financial institution. That is, there is a bank account in the name of the person or family. The applicant contends that the language of "...a person being associated with a specific account with a financial institution..." would be difficult to misconstrue by a person with ordinary skill in the art. The applicant therefore petitions the Examiner to simply withdraw the rejection under § 112.

In the present action the Examiner has rejected claims 1-7 and 13-19 under 35 U.S.C. 103(a) over Gruber et al., US publication 2002/0029179, hereinafter Gruber, and claims 8-12 and 20-24 under 35 U.S.C. 103(a) over Gruber in view of Cohen, US Patent 6,422,462.

After carefully studying the applied references and the statements and reasoning made by the Examiner in the instant action, the applicant is of the firm opinion that the rejections do not meet the Prima Facie standard, as they do not consider all of the limitations of the claims, nor do the references teach or imply all of the limitations, that

there are other serious errors in the action, and that the claims as last amended and presented again in this response without further amendment are clearly and unarguably patentable over the art cited and applied.

As an aid in making the points to follow the applicant presents here claim 1 as amended above:

1. A system for managing donations comprising:

an Internet-connected server accessible by donors using an Internet browser;

a data store accessible to the server and storing information about individuals or families, pre-qualified for donations and associated each with a specific account with a financial institution, the account enabling the potential donors to make contributions and the pre-qualified individuals or families to withdraw donated funds; and

software executing on the server, enabling the donors to obtain specific information about the pre-qualified individuals or families, and also enabling the donors to select one or more of the pre-qualified individuals or families and to make donations to the specific accounts associated with the selected pre-qualified individuals or families.

The applicant had previously claimed "*a data store accessible to the server and storing information about potential recipients pre-qualified for donations*", and in response to previous rejection over Gruber amended the language to the present "*a data store accessible to the server and storing information about individuals or families, pre-qualified for donations and associated each with a specific account with a financial institution, the account enabling the potential donors to make contributions and the pre-qualified individuals or families to withdraw donated funds*".

Applicant states for the record that the purpose of the amendment with considerably more narrow limitations is to specifically distinguish the "recipients" from charitable intermediary institutions like the American Red Cross, or more specifically Gruber, who is a prime example of an intermediary in the prior art that stands between

donors and recipients and exercises control over who gets the money donated and how they get the money.

Beginning with the "Response to Arguments" section starting on page 3 of the action, the Examiner states:

"Applicant has amended the claims to recite 'a data store accessible to the server and storing information about individuals or families...'. Previously the claim 1 recited "a data store accessible to the server and storing information about potential recipients". To one of ordinary skill, however, individuals or families are "recipients". Therefore, an obvious modification to the teaching of Gruber et al. would be to a charitable organization (figures 8 and 9) that represents a specific individual or family needing to raise money to pay for a family member's operation. Further, in order to pay for a surgery (or promote arthritis research, save the whales, encourage reading, etc.) the family would need to access any donated funds therefore, Gruber et al. also teaches or at least clearly suggests withdrawing the funds."

The Examiner thus attempts to finesse the additional limitation. The Examiner contends that to the skilled artisan individuals or families are recipients, and implies thereby that there is really no additional limitation. The problem with this reasoning is that while all Buicks may be automobiles, all automobiles are certainly not necessarily Buicks. The applicant contends there is no possibility that one of ordinary skill in the art would consider the American Red Cross, Gruber, or any other intermediary collecting donations for distribution to individuals or families to be themselves (the intermediaries) the individuals or families they pretend to represent. The two are clearly separate and clearly distinguishable entities. The new claim language specifically excludes such intermediaries from the class of the intended final recipients.

In addition the Examiner ignores the limitation that each pre-qualified individual or family is associated with a specific account at a financial institution, and that it is the account associated with the individual or person that enables a donor to make a donation to that specific individual or person. No such thing exists in Gruber or in any other cited reference.

The Examiner attempts to deal with the limitation of the pre-qualified individuals or families being enabled to withdraw donated funds by stating that this is suggested by Gruber because the family would need to withdraw the funds. The error here is that there is no facility or ability in Gruber, regardless of need, or in any other intermediary system, for a potential recipient to access or withdraw funds. This is precisely the motivation for the limitation. It is not allowed in Gruber or any such system for a final recipient of aid to control access to or withdrawal of funds. This is a limitation only in applicant's presently recited claim 1.

The Examiner deals with the software limitations of applicant's amended claim 1: "*software executing on the server, enabling the donors to obtain specific information about the pre-qualified individuals or families, and also enabling the donors to select one or more of the pre-qualified individuals or families and to make donations to the specific accounts associated with the selected pre-qualified individuals or families*", by stating that "these tasks are never actually performed and the software merely enables the task to occur or potentially occur ("to be", "may be' or "enable" language). To one of ordinary skill, a server is a computer, and a computer utilizes software such as an operating system, that *enables* the server to be *programmed* to perform numerous tasks (e.g. search databases, pay for goods and services, send email and play music online). Hence, the server of Gruber et al. necessarily comprises Applicant's *enabling* software."

The Examiner ignores that clear fact that in the recited claim the programming is a fact, not an intention. It is notoriously settled practice in the USPTO that a computer enhanced with software that performs a specific function is a new machine, and that functional limitation of computerized machines is correctly done by such recitation. The Examiner's contention that this language merely indicates that programming might be done is spurious. The language of the claim limits the invention to a system that actually performs these functions.

Clearly Gruber does not teach specifically the limitations of applicant's claim 1, and the limitations cannot be inferred by Gruber. Claim 1 is therefore clearly patentable over Gruber, and claims 2-12 are patentable on their merits or at least as depended from a patentable claim.

As to claims 13-24 the primary reference Gruber is so woefully inadequate that these claims are patentable by the same arguments presented above on behalf of claims 1-12.

As all of the claims standing for examination have been clearly demonstrated to be patentable as amended over the art of record, applicant respectfully requests reconsideration, and that the present case be passed quickly to issue. If there are any time extensions needed beyond any extension specifically requested with this response, such extension of time is hereby requested. If there are any fees due beyond any fees paid with this amendment, authorization is given to deduct such fees from deposit account 50-0534.

Respectfully Submitted,
Mark Andrew Boys

By */Donald R. Boys/*
Donald R. Boys
Reg. No. 35,074

Central Coast Patent Agency
P.O. Box 187
Aromas, CA 95004
(831) 726-1457